

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I hereby certify that this paper or fee is being deposited on May 21, 2001 with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 as Express Mail Label No. EL516389455US and is addressed to: **Box PCT**, Commissioner for Patents, Washington, D.C. 20231.

Signature: JOSE GUTIERREZName: **Jose Gutierrez**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Jin JEN, et al.

Application Serial No. 09/646,478
(PCT Application No. PCT/US99/06947)

International Filing Date: 30 March 1999

For: **METHODS FOR THE DIAGNOSIS AND
TREATMENT OF LUNG CANCER**

Examiner: Not Yet Examined

Group Art Unit: Not Yet Assigned

Attorney's Docket No. 126881-201800

RECEIVED**31 MAY 2001**Legal Staff
International Division

RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE

BOX: PCTCommissioner for Patents
Washington, D.C. 20231

Dear Sir:

This paper is submitted in response to the Notification of a Defective Response issued by the U.S. Patent and Trademark Office on April 20, 2001 in connection with the above-identified application. A copy of the Notice is attached. A response to the Notice is due one month from the date of mailing, *i.e.*, on or before May 20, 2001. However, because May 20, 2001 falls on a Sunday, a response filed the next business day, namely, Monday, May 21, 2001 is considered timely under 37 C.F.R. § 1.7. Accordingly, this response is timely filed.

The Notification indicated that the oath or declaration of inventors filed January 11, 2001 for the subject application did not comply with 37 C.F.R. § 1.497(a) and (b) on the ground that the fifth inventor listed on the oath was not listed in International Application No. CT/US99/06947, upon which the subject application was based.

Applicants' undersigned attorney acknowledges that the fifth coinventor David Sidransky was not listed on the International Application No. PCT/US99/06947 because, at

the time of the filing of the international application, his contribution to the claims was unknown. However, upon investigation into the inventorship of the claims, David Sidransky was added as a coinventor of the claims.

Applicants respectfully request that David Sidransky be added as a coinventor of the application upon the filing of the executed oath filed January 11, 2001. In support of this request, Applicants' undersigned attorney directs the Office's attention to 37 C.F.R.

§ 1.48(f)(1): which states:

If the correct inventor or inventors are not named on filing a nonprovisional application under Sec. 1.53(b) without an executed oath or declaration under Sec. 1.63, **the later submission of an executed oath or declaration under Sec. 1.63 during the pendency of the application will act to correct the earlier identification of inventorship.**

Emphasis added.

Applicants' oath filed on January 11, 2001 was the first submission of an executed oath or declaration in connection with the subject application. Pursuant to 37 C.F.R. § 1.48(f)(1), the filing of this paper should "act to correct the earlier identification of inventorship." 37 C.F.R. § 1.48(f)(1). Removal of the Objection to the inventors' oath filed in connection with the subject application is respectfully requested. The addition of David Sidransky as a coinventor of the claimed subject matter is further respectfully requested.

No fee is deemed necessary in connection with the filing of this paper. However, if any fee is required, authorization is given to charge the amount of this fee to **Deposit Account No. 50-0974**, referencing attorney docket no. **126881-201800**.

03/20/2002 UEDUWIJE 00000131 501189 09646478
01 FC:122 130.00 CN

Respectfully submitted,

Date: May 21, 2001


Antoinette F. Konski (Reg. No. 34,202)

Baker & McKenzie
660 Hansen Way
Palo Alto, California 94304
Telephone: (650) 856-2400
Facsimile: (650) 856-9299

Enclosures: Copy of April 20, 2001 Notification
Copy of Inventors' Oath filed January 11, 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/646478	JIN JEN	G 126881201800
INTERNATIONAL APPLICATION NO.		
PCT/US99/06947		
I.A. FILING DATE	PRIORITY DATE	
30 MAR 99	31 MAR 98	

BAKER & MCKENZIE
660 HANSEN WAY
PALO ALTO, CA 94304

DATE MAILED: 20 APR 2001

NOTIFICATION OF A DEFECTIVE RESPONSE

1. ☐ The request for an extension of time (37 CFR 1.136(a)) filed _____ is defective because the required fee is missing/insufficient. Extension of time fees are listed at 37 CFR 1.17(a)(1)-(a)(5).
2. ☐ Applicant's response filed _____ was received in the Office after the expiration of the period for response set in the Office notification mailed _____. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office notification under 37 CFR 1.136(a).
3. ☒ Applicant's response filed 17 JAN 01 is hereby acknowledged. The following requirements set forth in the NOTIFICATION of MISSING REQUIREMENTS (Form PCT/DO/EO/905) mailed 13 OCT 00 have not been completed.

- ☐ Translation of the international application into English.
☐ which is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ Processing fee (37 CFR 1.492(f)).
- ☒ Oath or Declaration of inventors(s).
☒ not in compliance with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☒ Surcharge (37 CFR 1.492(e)).
- ☐ Sequence Listing.
☐ not in compliance with 37 CFR 1.821-1.825 for the reasons indicated on the attached PCT/DO/EO/920.
- ☐ Additional claim fees.

Baker & McKenzie

APR 26 2001

Received
Patent Dept.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements (Form DO/EO/905), whichever is the longer. No extension of this time limit may be granted under 37 C.F.R. § 1.136, but the period for response set in the Notification of Missing Requirements (Form DO/EO/905) may be extended under 37 C.F.R. § 1.136(a).

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PCT/DO/EO/920

Karen Williams

Telephone: 703-305-3688



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/646478	JIN JEN	G 126881201800
INTERNATIONAL APPLICATION NO.		

BAKER & MCKENZIE
660 HANSEN WAY
PALO ALTO, CA 94304

PCT/US99/06947

I.A. FILING DATE	PRIORITY DATE
30 MAR 99	31 MAR 98

DATE MAILED: 20 APR 2001

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America. The period within which to correct the deficiency noted below and avoid abandonment is set in the accompanying Notification.

A new oath or declaration, properly identifying this application (preferably by the international application number and international filing date) is required. The oath or declaration does not comply with 37 CFR 1.497(a),(b) and (f) in that it:

1. ☐ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the application to which it is directed.
3. ☒ does not identify the inventor(s). FIFTH INVENTOR NOT LISTED ON INTERNATIONAL APPLICATION
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b), AND 1.497(d) WHERE APPROPRIATE, WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the mailing address of each inventor. If the residence is different from the mailing address, then the city and state or city and foreign country of residence of each inventor must also be given.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.

Karen Williams

Telephone: 703-305-3688

FIRST CLASS MAIL

Date Mailed

January 11, 2001

Due Date: January 13, 2001
Atty. Docket: 126861-201800

Applicant(s): Jin JEN, et al.

Title: Methods for the Diagnosis and Treatment of Lung Cancer

Application No.: 09/646,478
(PCT/US99/06947)

Filing Date: September 15, 2000
(March 30, 1999)

Examiner: Unassigned

Group Art Unit: Unassigned

BOX MISSING PARTS

Commissioner for Patents
Washington, DC 20231

SIR:

Please place the U.S. Patent and Trademark Office date stamp hereon to acknowledge receipt of the following:

1. Response to Notice of Missing Requirements (in duplicate);
2. Petition for Extension of Time (2 months - in duplicate);
3. Executed Declaration (6 pages) and Prosecution by Assignee and Power of Attorney (2 pages); Certificate under 37 CFR 3.73 (b) with copy of Recordation Form Cover Sheet and Assignment (8 pages);
4. Copy of Notice; Check No.1220 in the amount of \$520.00; and
5. Return postcard.

MAIL DATE CANCELLED
JAN 16 2001
PATENT & TRADEMARK OFFICE

PATENT
DOCKET NO.: 126881201800

DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION
(37 C.F.R. § 1.63)

AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled: **METHODS FOR THE DIAGNOSIS AND TREATMENT OF LUNG CANCER**, the specification of which is attached hereto unless the following box is checked:

☐ is attached hereto

OR

☒ was filed on March 30, 1999 as United States Application Serial No. or PCT International Application No. PCT/US99/06947 and was amended on _____ (if applicable).

I HEREBY STATE THAT I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED TO ABOVE.

I acknowledge the duty to disclose information which is material to the patentability as defined in 37 C.F.R. § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States of America listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed:

Application Number	Country	Filing Date (mm/dd/yyyy)	Priority Claimed
			<input type="checkbox"/> Yes <input type="checkbox"/> No

I hereby claim benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

Application Number	Filing Date
60/080,044	03/31/1998

I hereby claim the benefit under 35 U.S.C. § 120 of the United States application(s), or § 365(c) of any PCT International application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

PCT Patent Number	Filing Date (Month/Day/Year)	Priority Date (Month/Day/Year)
PCT/US99/06947	03/30/1999	

Please direct all communications to:

Antoinette F. Konski, Esq.
Baker & McKenzie
660 Hansen Way
Palo Alto, California 94304
Telephone: (650) 856-2400
Facsimile: (650) 856-9299

Please direct all telephone calls to Antoinette F. Konski at (650) 856-5564.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title of 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: _____

By: _____

Name: Jin Jen
Residence: 2104 Heritage Drive, Baltimore, Maryland 21209
Citizenship: US
Post Office Address: Same as above

Date: 12/8/00

By: _____

Name: Gary A. Beaudry
Residence: ~~109 Inwood Avenue, Montclair, New Jersey 07043~~
Citizenship: US ~~24 MONTCLAIR AVE, MONTCLAIR NEW JERSEY 07043~~
Post Office Address: Same as above

Date: _____

By: _____

Name: Stephen L. Madden
Residence: 137 Nobscot Road, Sudbury, Massachusetts 01776
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: Arthur H. Bertlesen
Residence: 215 Manor Road, Ridgewood, New Jersey 07450
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: David Sidransky
Residence: 3007 Northbrook Road, Baltimore, MD 21209
Citizenship: US
Post Office Address: Same as above

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Date: _____

By: _____

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Residence: 2104 Heritage Drive, Baltimore, Maryland 21209
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: Gary A. Beaudry
Residence: 109 Inwood Avenue, Montclair, New Jersey 07043
Citizenship: US
Post Office Address: Same as above

Date: 12-19-00By: 

Name: Stephen L. Madden
Residence: 137 Nobscot Road, Sudbury, Massachusetts 01776
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: Arthur H. Bertlesen
Residence: 215 Manor Road, Ridgewood, New Jersey 07450
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: David Sidransky
Residence: 3007 Northbook Road, Baltimore, MD 21209
Citizenship: US
Post Office Address: Same as above

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Residence: 2104 Heritage Drive, Baltimore, Maryland 21209
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Post Office Address: Same as above

Date: _____ By: _____

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Residence: 109 Inwood Avenue, Montclair, New Jersey 07043
Citizenship: US
Post Office Address: Same as above

Date: _____ By: _____

Name: Stephen L. Madden
Residence: 137 Nobscot Road, Sudbury, Massachusetts 01776
Citizenship: US
Post Office Address: Same as above

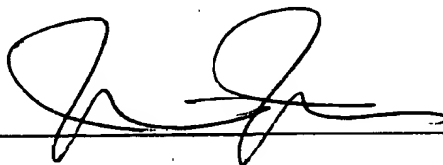
Date: 12-6-00 By: 

Name: Arthur H. Bertlesen
Residence: 215 Manor Road, Ridgewood, New Jersey 07450
Citizenship: US
Post Office Address: Same as above

Date: _____ By: _____

Name: David Sidransky
Residence: 3007 Northbrook Road, Baltimore, MD 21209
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Post Office Address: Same as above

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Date: 1/3/01By: 

Name: Jin Jen
Residence: 2104 Heritage Drive, Baltimore, Maryland 21209
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: Gary A. Beaudry
Residence: 109 Inwood Avenue, Montclair, New Jersey 07043
Citizenship: US
Post Office Address: Same as above

Date: _____

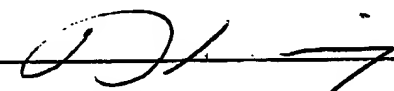
By: _____

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Residence: 137 Nobscot Road, Sudbury, Massachusetts 01776
Citizenship: US
Post Office Address: Same as above

Date: _____

By: _____

Name: Arthur H. Bertlesen
Residence: 215 Manor Road, Ridgewood, New Jersey 07450
Citizenship: US
Post Office Address: Same as above

Date: 1/4/01By: 

Name: David Sidransky
Residence: 3007 Northbook Road, Baltimore, MD 21209
Citizenship: US
Post Office Address: Same as above